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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,826	01/25/2006	Louis Jourdain	17919-1US ADA	7493
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OGILVY RENAULT LLP 1, Place Ville Marie SUITE 2500 MONTREAL, QC H3B 1R1 CANADA			BYRD, LATRICE CHENELL	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,826	<b>Applicant(s)</b> JOURDAIN, LOUIS	
	<b>Examiner</b> LATRICE BYRD	<b>Art Unit</b> 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/8/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951) in view Smith et al. (USPN 6,045,038) and Rinde (USPN 6,182,823B1).

3. In re claim 1, Auerbach discloses a paper dispenser made of a folded single sheet of pliable material and having a substantially frustopyramidal exterior shape with an opened top and a closed bottom, characterized in that it comprises four exterior walls (21,32) defining the frustopyramidal shape and four interior walls (22,33) delimiting a rectangular-prism-shaped paper-receiving compartment, wherein said exterior walls are spaced apart from corresponding ones of said interior walls in order to create a space between them. Auerbach fails to disclose at least one of the interior walls has an exterior face having an illustration or marking and in at least one of said exterior walls comprises an opening allowing to see therethrough the illustration or marking on the interior wall. However, Smith et al. teaches a container with an interior (15) and exterior (11) wall spaced apart having an opening (213) in the exterior wall allowing a decoration on an interior wall to show through. Further, Rinde teaches a container with an interior

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(68) wall and exterior (66) wall having an opening (16) allowing an illustration on an interior wall to show through. It would have been obvious to one of ordinary skill in the art at the time of the invention to form a display including an inner advertisement/representation and an outer window in the double walled box of Auerbach as taught by Smith et al. for the purpose of making the box more aestically pleasing and/or to advertise the contents. It would further have been obvious to one of ordinary skill in the art at the time of the invention to substitute an illustration for the representation in modified Auerbach as taught by Rinde as a simple substitution of one well known form of box advertising/information display for another to obtain the clearly predictable results of using such an illustration.

4. In re claim 3, Auerbach discloses a paper dispenser wherein said pliable material is cardboard.

5. In re claim 4, Auerbach discloses the claimed invention except wherein said opening is covered with a transparent or translucent liner. However, Rinde teaches an opening (16) being covered with a translucent liner (18). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the exterior wall of Auerbach by including the translucent liner over an opening as taught Rinde in order to protect the illustration on the interior wall from damage.

6. In re claim 5, Auerbach discloses a paper dispenser wherein said single sheet of pliable material, prior to folding, comprises a substantially cross-shaped center portion and four side portions, wherein said cross-shaped center portion comprises a middle section (12) that, once folded, becomes the bottom of said paper dispenser, and four

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adjacent sections (21,32), adjacent the middle section, which once folded become the exterior walls, wherein the four side portions are connected to corresponding ones of the four adjacent sections, opposite the middle section, and each comprise a panel (22,33) which once folded will become a corresponding one of the interior walls.

7. In re claim 12, Auerbach discloses a paper dispenser wherein the four side portions include a first pair (33) of opposed ones of the side portions, and a second pair (22) of opposed ones of the side portions, each side portion of the first pair having two opposite lateral sections (27-30) which interlockingly engage with the other two opposite lateral sections once folded, and a flap (34) which comes into abutment with a corresponding one of the exterior walls once folded.

8. In re claim 17, Auerbach discloses a paper dispenser wherein the rectangular prism shape of the paper receiving compartment is cubical before the partitions are added as seen in figure 7.

9. Claims 2 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951), Smith et al. (USPN 6,045,038) and Rinde (USPN 6,182,823B1) as applied to claim 1 above, in further in view Wynne et al. (USPN 2,339,445).

10. In re claims 2 and 7, Auerbach discloses the claimed invention except a slot extending downwardly from the top of both one of the exterior walls and a corresponding one of the interior walls wherein half the slot is provided in the exterior wall and other half into side portion adjacent the exterior wall. However, Wynne et al. teaches a slot extending downwardly from the top of both an exterior wall (11) and an

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interior wall (14) which is provided in both the exterior and interior wall. It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the walls of Auerbach to include a slot in the interior and exterior wall as taught by Wynne et al. in order to provide access to the contents of the container.

11. In re claim 8, Auerbach discloses a paper dispenser wherein said side portion comprises two opposite lateral sections (27-30) and a flap (34).

12. In re claim 9, Auerbach discloses a paper dispenser wherein said lateral sections are symmetrical with reference to said interior wall.

13. In re claim 10, Auerbach discloses a paper dispenser wherein each one of said lateral sections comprises two slots (31) separated by an inclined edge designed to provide an interlocking engagement with slots of corresponding side sections of an opposite side portion, said opposite side portion also comprising a flap (34).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951), Smith et al. (USPN 6,045,038) and Rinde (USPN 6,182,823B1) as applied to claim 5 above, in further in view Wood (USPN 3,347,445) and Haas (USPN 3,122,299).

15. In re claim 6, Auerbach discloses the claimed except the cross-shaped center comprising four pairs of flaps. However, both Wood and Haas teach a container having a crossed-shaped center portion comprising four pairs of flaps (Wood 46,47,51,52,56,57,61,62 and Haas 50), with one pair of flaps being disposed at each inner corner of the cross-shaped center portion. It would have been obvious to one of ordinary skill in the art at the time of the invention to have substituted the tongues 20 of

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Auerbach with the pairs of flaps disposed at each inner corner as taught by Wood or Haas in order to serve as a means of tying the side walls to the exterior and interior walls.

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951), Smith et al. (USPN 6,045,038) and Rinde (USPN 6,182,823B1) as applied to claim 12 above, in further in view Hillmann (USPN 684,243).

17. In re claim 13, Auerbach discloses the claimed invention except wherein each side portion of the second pair has a flap which precisely fits between the four interior walls when folded against the bottom of the paper dispenser. However, Hillmann teaches side portions having flaps ( $A^2$ ) which fit precisely between four interior walls ( $B^2, C^2$ ) when folded against the bottom of the box. It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the side portions of Auerbach to include flaps as taught by Hillmann in order to retain the inner walls and hold them in place rendering it impossible for them to escape position.

18. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951) in view Smith et al. (USPN 6,045,038) and Hillmann (USPN 684,243).

19. In re claim 14, Auerbach discloses a paper dispenser made of a folded single sheet of pliable material and having a substantially frustopyramidal exterior shape with an opened top and a closed bottom, characterized in that it comprises four exterior walls (21,32) defining the frustopyramidal shape and four interior walls (22,33) delimiting a rectangular-prism-shaped paper-receiving compartment, wherein said exterior walls are

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spaced apart from corresponding ones of said interior walls in order to create a space between them, said single sheet of pliable material, prior to folding, having a substantially cross-shaped center portion and four side portions, wherein said cross-shaped center portion comprises a middle section (12) that, once folded, becomes the bottom of said paper dispenser, and four adjacent sections (21,32), adjacent the middle section, which once folded become the exterior walls, wherein the four side portions are connected to corresponding ones of the four adjacent sections, opposite the middle section, and each comprise a panel (22,33) which once folded will become a corresponding one of the interior walls; the four side portions including a first pair of opposed ones of the side portions, and a second pair of opposed ones of the side portions, each side portion of the first pair having two opposite lateral sections (27-30) which interlockingly engage with the other two opposite lateral sections once folded, and a flap (34) which comes into abutment with a corresponding one of the exterior walls once folded. Auerbach fails to disclose the exterior wall having an opening and the second pair of side portions having a flap which precisely fits between the four interior walls when folded. However, Smith et al. teaches an opening (213) in an exterior wall (12) and Hillmann teaches flaps ( $A^2$ ) extending from a second pair of side portions between four interior walls ( $B^2, C^2$ ). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the container of Auerbach to include an opening in the exterior wall as taught by Smith et al. and a flap extending from the side portion as taught by Hillmann in order to display decorations on



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an interior wall through an interior wall and to retain the inner walls and hold them in place rendering it impossible for them to escape position, respectively.

20. In re claim 18, Auerbach discloses a paper dispenser wherein the rectangular prism shape of the paper receiving compartment is cubical before the partitions are added as seen in figure 7.

21. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951), Smith et al. (USPN 6,045,038) and Hillmann (USPN 684,243) as applied to claim 14 above, in further in view Rinde (USPN 6,182,823B1).

22. In re claim 15, Auerbach discloses the claimed invention except the exterior face of the interior wall having an illustration or marking visible through an opening.

However, Rinde teaches an illustration (22) on the exterior face of an interior wall (68) visible through an opening (72) in the exterior wall (66). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the interior wall of Auerbach with an illustration as taught by Rinde in order to provide a display for the consumer to identify the product that may be three-dimensional and aesthetically pleasing.

23. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (USPN 1,492,951), Smith et al. (USPN 6,045,038) and Hillmann (USPN 684,243) as applied to claim 14 above, in further in view Wynne et al. (USPN 2,339,445).

24. In re claim 16, Auerbach discloses the claimed invention except a slot extending downwardly from the top of both the exterior and interior walls. However, Wynne et al.

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teaches a slot extending downwardly from the top of both an exterior wall (11) and an interior wall (14) which is provided in both the exterior and interior wall. It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the walls of Auerbach to include a slot in the interior and exterior wall as taught by Wynne et al. in order to provide access to the contents of the container.

### ***Response to Arguments***

25. Applicant's arguments filed 11/20/09 have been fully considered but they are not persuasive.

26. In response to applicant's arguments, the recitation "a paper dispenser" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

27. In response to applicant's argument that Auerbach does not disclose a paper-receiving compartment, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Although

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Auerbach uses the dispenser for receiving candy, the dispenser is also capable of receiving paper.

28. In response to applicant's argument that the use of separators would actually prevent rectangular papers from fitting inside the container, Applicant has not claimed that the paper is rectangular. Also, paper is not always rectangularly shaped, therefore it cannot be assumed that the paper being received is rectangular. Paper may be cut into any shape. Furthermore, the separators may be eliminated from the container, providing a rectangular paper-receiving compartment.

29. In response to applicant's argument to disagree with Examiner's suggestion to combine Auerbach with Smith et al. and Rinde, though the references are all not used for dispensing paper, they each are containers for receiving an article. Furthermore, it would be obvious to display or advertise whatever the article being contained, be it paper, candy or CD. The actual contents being advertised are a choice of the retailer to please its desired consumer. There is no structural difference.

30. In response to applicant's argument that dispensing articles such as candy, chewing gum, and so forth is simply not related to allowing digital access to dispense paper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

31. Applicant's arguments of claim 13 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without

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specifically pointing out how the language of the claims patentably distinguishes them from the references. A mere statement that “it would not have been plain and unambiguous that the flaps taught by Hillmann could be used in a frusto-pyramidal paper dispenser, does not specifically point out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LATRICE BYRD whose telephone number is (571)270-5703. The examiner can normally be reached on Mon-Thu 9:30am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LATRICE BYRD/  
Examiner, Art Unit 3782

/Gary E. Elkins/  
Primary Examiner, Art Unit 3782